REMARKS

Applicants express appreciation to the Examiner for the recent interview held with Applicants' representative. As presented herein for reconsideration, the claims have been amended as proposed at the interview. Specifically, claims 1, 5, 7–8, 10–11, 15–17, 22, 25, 27–29, and 32 have been amended and claims 2, 18, and 33–36 have been cancelled. Thus, by this paper, claims 1, 3-17, and 19–32 are pending. Claims 1 and 17 are the independent claims which remain at issue. Support for the amendments may be found, *inter alia*, at ¶¶ 10–12, 21, 37–38, and 41 and Figures 3 and 4 of the Specification.[1]

In the Office Action claims 1, 17, 28 and 32 were rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. In particular, the Office Action noted that the term "computer-readable media," as defined in the Specification, implies the "invention calls for a signal *per se* which is not tangibly embodied." Each of the claims has now been amended to recite "computer-readable *storage* media" so as to exclude from the claims a medium in the form of wireless signals.[2]

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[1] Note that the paragraph numbers are taken from the published application, U.S. Pat. Pub. 20050198148.

[2] Applicants reserve the right, however, to further challenge this ground of rejection by way of presenting claims which define the computer readable medium in terms consistent with the breadth of that term as provided in applicants' specification.

On a strictly factual basis it is highly questionable whether a signal or carrier wave is not tangible. Simply because one cannot see or touch the medium does not change the reality that such a medium nonetheless is real and is used every day to transmit and download software just as effectively as software contained on a CD. The asserted reason for treating so-called "signal" claims differently from other kinds of computer readable media (e.g., that wireless signals are "energy" that as such "is not a physical article or object" (e.g., not "tangible"), simply does not square with the fact that such wireless signals, no less than other more "physical" media such as disks or CDs, works in the exactly the same way - executable instructions on a disk or CD, like those carried by a signal, also cannot be understood or executed until those computer-executable instructions are off-loaded from the disk or CD into the computer's RAM. This is no different for a carrier signal. Hence the asserted factual distinction as to the claims being directed to "a signal *per se* which is not tangibly embodied" is no different than saying that a computer program product claim limited to a "physical" storage medium such as a disk is nothing more than a claim to simply the disk, which of course is not the position of the Office.

Moreover, there are sound policy reasons why a signal or carrier wave used to provide software to users should be treated no differently for purposes of patent eligibility than a computer disc such a CD or floppy disk which provides such software. To deny patent eligibility for such claims is to ignore the reality that such media is most certainly employed in the using and selling of software carried by such a medium, and thus denies claims to a patent owner that would otherwise provide a basis for asserting direct infringement against competitors who sell patented software using wireless connectivity, thereby relegating such subject matter to assertions of indirect infringement only, with no sound policy basis for doing so. To deny such computer program products of patent protection on this basis appears to be exalting form over substance. Thus, the asserted basis for treating a wireless computer-readable medium differently for purposes of patent eligibility is simply untenable, on grounds of both underlying factual inconsistency and questionable policy.

As presented herein for reconsideration, independent claims 1 (directed to a method) and 17 (directed to a corresponding computer-program product for implementing the method) define a method for enforcing a message exchange pattern by restricting the transmission of an invalid message which does not conform to the current state of the message pattern. Enforcing the message pattern thereby preserves network bandwidth and processing resources by making sure that invalid messages are not transmitted.

As defined in the independent claims, the method is comprised of "storing a state transition tree for the message exchange pattern in which each node of the tree represents a state of the message exchange pattern and in which a transmission or a receipt of a message causes a state transition to an appropriate next node in the tree. Next, at a current node in the state transition tree, a request to transmit a message at the computing system is detected. At that point, and *based on the current state in the message exchange pattern,*" (emphasis added) it is determined whether the request to transmit the message renders the message valid or invalid. Lastly, if the message is determined to be a valid message given the current node, it is transmitted and then the state transition tree is transitioned to the appropriate next node in the tree. On the other hand, if it is determined that the message is not a valid message to be sent given the current node in the tree, transmission of the message is prevented and the component attempting to send the message is notified that the message is not a valid message.

In the Office Action claims 1–10, 12–30 and 32–36 were rejected under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent No. 7,249,195 (Panec). Claims 11 and 31 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Panec.[3]

Panec describes methods and systems for *correlating* messages sent between services where *correlation* information is stored for each message transmitted between the services. Thus, on the one hand, while Panec keeps records of *correlation* information of messages sent and received (e.g., which messages originated with which service, and pertain to other messages), that is not at all like storing a state transition tree for a message exchange pattern and using that state transition tree to determine, based on the current node for a message, *whether that message is valid or invalid* is the first instance, based on the possible next states in the

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[3] Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art. Accordingly, any arguments and amendments made herein should not be construed as acquiescence in the status of any reference as to whether it actually qualifies as "prior" art.

exchange pattern for the message. Indeed, for these reasons, as noted by the Examiner in the interview summary, the "Applicants' proposed amendments to the independent claims . . . as discussed, appears to overcome the art of record."

For at least the reasons noted[4] Applicants respectfully submit that as presented herein for reconsideration, the independent claims and the claims depending from them are patentable over the prior art of record, and specifically over Panec as discussed. Since there are no other rejections of record in the Office Action, Applicants respectfully request favorable reconsideration in view of the amendments, remarks herein and discussion at the interview, and favorable action.

In the event the Examiner finds any remaining impediment to allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 18th day of June, 2008.

Respectfully submitted,

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[4] In view of the foregoing, Applicants respectfully submit that any other rejections (for example, those pertaining to dependent claims) are now moot and do not, therefore, need to be addressed individually. It will be appreciated, however, that this should not be construed as Applicants' acquiescence in any other rejections not specifically addressed herein.